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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,054	12/31/2001	Rajeev K. Nalawadi	42390P12867	9089

8791 7590 07/13/2005

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EXAMINER

BAE, JI H

ART UNIT

PAPER NUMBER

2115

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,054

Applicant(s)

NALAWADI ET AL.

Examiner

Ji H. Bae

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites a method for executing a predetermined process in a SMM (system management mode) while operating under ACPI control, comprising:

generating a SMI (system management interrupt) request under ACPI control;
changing an operation mode of a processor to the SMM in response to the SMI request;
and
executing a resume ACPI control process to return the processor to ACPI control after the process is complete.

Applicant has not provided sufficient detail in the disclosure such that one of ordinary skill in the art would have been able to make and/or use the invention without undue experimentation. In particular, applicant has not taught how SMI would be generated and used in a system under ACPI control.

The prior art teaches that ACPI systems use SCI (system control interrupts) rather than SMI, and that SMI is a legacy feature found in non-ACPI systems:

According to applicant's teaching, the ACPI hardware interface provides functionality to the OS in control/detection of system control tasks using a normal interrupt called System

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Control Interrupt ("SCI"), rather than a System Management Interrupt ("SMI") [specification, page 1, paragraph 0003];

The ACPI Specification v2.0 teaches that in order to support SMI on an ACPI system, the system must provide hardware to support generation of SMI. It is noted that in such a system, the use of SMI and SCI is mutually exclusive depending on whether the OS loaded onto the system is an ACPI-compatible system [page 50, Fig. 4-3, "Interrupt Events"];

The ACPI Specification teaches that ACPI operating systems use the SCI interrupt handler to respond to events, while legacy systems use SMI interrupt handlers [page 50, first paragraph];

The ACPI Specification teaches that ACPI system may support both SCI and SMI interrupt handlers in a mutually exclusive fashion that depends on whether ACPI is enabled on the system [page 50, Fig. 4-12].

Because the prior art teaches contrary to applicant's disclosure, and because applicant's disclosure has not sufficiently detailed how to implement the use of SMI with an ACPI-compatible system, applicant's disclosure does not enable one of ordinary skill in the art to make or use the invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Cooper, U.S. Patent No. 6,792,491 B2;

Engfer et al., U.S. Patent No. 6,321,289 B1;

Gephardt, U.S. Patent No. 5,530,891;

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Goodman et al., U.S. Patent No. 6,282,601 B1;

Klein, U.S. Patent No. 6,212,592 B1;

Nijhawan, U.S. Patent No. 6,185,677 B1;

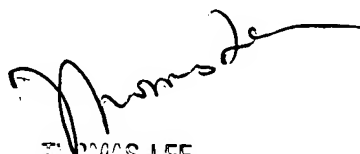
Stanley, U.S. Patent No. 6,219,742 B1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ji H. Bae whose telephone number is 571-272-7181. The examiner can normally be reached on Monday-Friday, 10 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Lee can be reached on 571-272-3667. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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